

05.27.03

AF  
3600

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application Number	09/650,843
		Filing Date	August 28, 2000
		First Named Inventor	H. Addison Sovine
		Group Art Unit	3641
		Examiner Name	Mark S. Graham
Total Number of Pages in This Submission	[Total # of Pages]	Attorney Docket No.	1135.ACT2.PT

## ENCLOSURES (check all that apply)

- ☐ Amendment / Response
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☒ Appeal Communication:
- ☐ Appeal Notice
- ☐ Appeal Brief
- ☒ Reply Brief
- ☐ Assignment with Cover Sheet
- ☐ Certified Copy of Priority Document(s)
- ☐ Check in the amount of \$\_\_
- ☐ Credit card authorization in the amount of \$\_\_
- ☐ Declaration & Power of Attorney
- ☐ Drawings \_\_ sheets
- ☐ Formal ☐ Informal

- ☐ Extension of Time Request  
\_\_\_\_ month
- ☐ Fee Calculation Table
- ☐ Information Disclosure Statement
- ☐ Form 1449
- ☐ Copies of IDS References
- ☐ Issue Fee Transmittal & Advance Order

- ☐ Maintenance Fee Transmittal  
\_\_\_\_ year
- ☐ Missing Parts Response
- ☐ Notification of Change of Attorney Address & Docket Number
- ☒ Return Postcard
- ☐ Revocation & Power of Attorney
- ☐ Status Inquiry
- ☐ Other:

Remarks

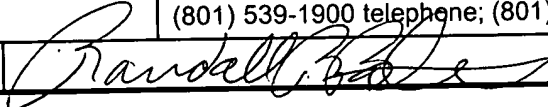
**RECEIVED**  
MAY 30 2003  
**GROUP 3600**

## SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Attorney for Applicant

Randall B. Bateman, Registration No. 37,774  
10 West 100 South, Suite 426  
P.O. Box 1319  
Salt Lake City, Utah 84110  
(801) 539-1900 telephone; (801) 322-1054 facsimile

Signature



Date

5-22-03

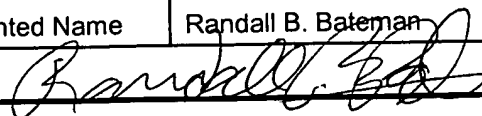
## CERTIFICATE OF MAILING UNDER 37 CFR § 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail, on the date indicated below, in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 *Express ERI15322705*

Typed or Printed Name

Randall B. Bateman

Signature



Date

5-22-03



14 19  
Reply Brief  
S. Zimmerman

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**In re Application of:**

H. Addison Sovine et al.

**Serial Number:** 09/650,843

**Filed:** August 28, 2000

**Group:** 3641

**Examiner:** Mark S. Graham

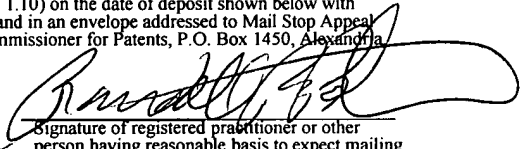
**For:** CLEARING TRAP

**Attorney Docket:** 1135.ACT2.PT

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence along with any attachments referred to or identified as being attached or enclosed is being deposited in triplicate with the United States Postal Service as Express Mail (under 37 C.F.R. § 1.10) on the date of deposit shown below with sufficient postage and in an envelope addressed to Mail Stop Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

May 22, 2003  
Date of Deposit

  
Signature of registered practitioner or other person having reasonable basis to expect mailing to occur on date of deposit shown pursuant to 37 C.F.R. § 1.10

Randall B. Bateman  
Typed/printed name of person whose signature is contained above

**RECEIVED**

**MAY 30 2003**

**GROUP 3600**

**REPLY BRIEF**

Commissioner of Patents  
Washington, D.C. 20231

Attention: Board of Patent Appeals and Interferences

Sirs:

In response to the Examiner's Answer, Applicant submits the following reply.

With respect to claims 1, 14 and 20, Applicant respectfully disagrees with the Examiner's analysis of both pieces of prior art, and what is necessary to make out a case of anticipation.

Claim 1 currently reads as follows:

1. (Amended) A trap for receiving bullets, the trap comprising:  
a housing having a cavity defined by an outerwall surrounding a void; and  
an insert forming a bullet deceleration chamber, the insert being slidably insertable into  
and removable from the void of the housing, the insert being formed of a bullet decelerating  
material and having an opening for receiving a barrel of a gun.

Neither Duer nor Fumero teach such a structure. Duer teaches a mesh basket which is placed in a bullet trap full of sand and is used to sift bullets out of the sand. The basket does not form a chamber as it would commonly be understood by one of ordinary skill in the art. To the contrary, the basket is formed by a planar screen member and a “relatively short” annular ring. (Col. 6, lines 23-34). Further, one of ordinary skill in the art would not consider mesh to be a bullet decelerating material. Thus, Duer cannot be said to anticipate the invention.

Likewise, Fumero does not anticipate the invention. Contrary to the Examiner’s assertion, the insert of Fumero does not have an opening for receiving the barrel of a gun. Rather, Fumero indicates that the insert is slid into the housing and is spaced several feet away from the opening which receives the barrel of the gun. (See FIG. 23). Thus, neither Duer nor Fumero anticipate claim 1.

With respect to claim 14, Applicant submits that the claim is allowable over the prior art. Claim 14 reads as follows:

14. (Amended) A clearing trap for receiving bullets fired from a gun, the clearing trap comprising:

a housing having an outerwall with an opening at one end and a void disposed within the outerwall; and

an insert disposed in the void of the housing, the insert forming a continuous, removable bullet deceleration chamber from a position adjacent the opening of the housing to an opposing end of the bullet deceleration chamber with the void.

Both Fumero and Duer lack a continuous, removable bullet deceleration insert as set forth in the claim. In Duer, the “relatively short” ring of the basket extends along a small fraction of the length of the housing. There is simply no good fair argument that the insert of Duer forms a continuous bullet deceleration chamber from a position adjacent the opening to an opposing end of the chamber. Duer specifically shows a substantial gap between the end of the “relatively short” ring and the opening in the housing.

With respect to the Examiner’s argument that the housing in Fumero can be considered only compartment 105, Applicant strenuously objects. The claim requires the opening to be at one end of the housing, and the housing having a void with the insert disposed therein. Based on the teachings of Fumero, one would understand the opening to be the top, not in the middle of the housing as now proposed by the Examiner. It is well established that the Examiner cannot pick and chose from portions of the prior art in order to deprecate the invention. Nor can the Examiner define the prior art one way to reject one claim and a completely different way to reject another claim. To do so would render the examination process meaningless. The application should be examined as it would be understood by one skilled in the art - not how many different ways the same disclosure can be reinterpreted to meet the various claim elements. A person of ordinary skill in the art would understand that the insert of Fumero is spaced substantially away from the opening in the housing. Therefore Fumero cannot be said to anticipate the claim and claims 14 and all claims dependent thereon should be allowed.

Turning now to claim 20, neither piece of prior art relied upon by the Examiner teaches sliding a bullet deceleration chamber into a housing having an open end through which a bullet travels. Duer's basket may be an insert, but it is not a bullet deceleration chamber. Indeed, Duer's basket is not formed from a material that would qualify as "bullet deceleration" material and does not form a substantial enclosure as the word chamber typically indicates. Thus, even replacing the basket with bullet deceleration material would not form a deceleration chamber.

Therefore, claim 20 and all claims depending thereon should be allowed.

Thus, both Duer and Fumero, alone or in combination, clearly lack the elements of claims 1, 14 and 20 and the claims should be allowed.

With respect to claim 7, there is no teaching in the art of a plate having "at least one slot formed therein." Indeed, the Examiner fails to even address this claim element. Accordingly, both claim 7 is independently allowable over the art cited by the Examiner.

With respect to claim 13, there is no teaching in the art that the housing is "formed from a material other than plate steel." Indeed, each of the prior art references specifically teach the use of a steel outer housing.

35 U.S.C. § 103(a)

The rejection of claims 2-6, 11 and 16 as being unpatentable under 35 U.S.C. § 103(a) in view of Fumero or Duer is improper and traversed.

The real issue under Section 103 is whether the Examiner has stated a case of prima facie obviousness.

The PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600.

In rejecting the claims, the Examiner repeatedly picks and chooses from the prior art without showing either a teaching in the reference or knowledge generally available which suggests the combination as required by abundant precedent. The Court of Appeals for the Federal Circuit has repeatedly rejected simply relying on "obvious to one skilled in the art" as the basis for such a combination. Moreover, in order for there to be a proper rejection under Section 103, the Examiner must demonstrate that the prior art contains the elements recited in the claims. *See e.g. W.L.Gore & Assocs., Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1993)

With respect to the rejections of claims 2-6, 11 and 16, Applicant objects to the Examiner's assertion that the ballistic duct portions of Fumero can be considered part of the insert. Not only is this inconsistent with his prior positions, it is simply inconsistent with the teachings of Fumero. It is clear from Fumero that such structures are not considered to be an insert or considered to be removable. Applicant submits that it is unfair in the examination context for the examiner to repeatedly reinterpret the prior art during examination. Applicant is held to the actual teachings of his disclosure and Examiner should be required to put forth a consistent analysis of the prior art upon which he relied.

The rejection of claims 8 and 9 as being unpatentable under 35 U.S.C. § 103(a) in view of Tabler is improper and traversed.

Claim 8 is allowable over Tabler. Claim 8 now includes elements specifically not taught or suggested by the prior art and the claim should be allowed. In addition to the lack of the

elements of claim 8 in the prior art, the Examiner has repeatedly extrapolated on the teachings of Tabler in an attempt to reject the claim. First, the art does not support the Examiner's conjecture that the plates are attached by rivets. It is common in the industry to weld plate steel because it is extremely difficult to drill. Second, even if a rivet were used, rivets usually are placed in holes, not slots. This would be especially so in the context of a ballistic trap. Third, there is simply no teaching that the bottom wall 40 has a slots formed therein, and no suggestion for such a modification.

With respect to claim 9, as discussed with reference to claim 8, there is no teaching in Tabler regarding slots, let alone whether the slots overlap or not. Indeed, the Examiner fails to even address this claim element. The basis for the Examiner's extrapolation regarding the existence of slots in claim 8 actually contradicts the rejection of claim 9. If slots were provided due to the use of rivets, etc., the slots would necessarily overlap. If they did not, the rivet could not function, as a rivet binds by extending through two aligned holes. Accordingly, both claims 8 and 9 are independently allowable over the art cited by the Examiner.

The rejection of claims 23-25 as being unpatentable under 35 U.S.C. § 103(a) over Duer in view of Fumero is improper and traversed.

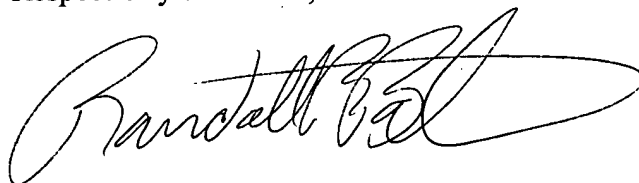
With respect to claim 23, as previously discussed, neither piece of prior art relied upon by the Examiner teaches sliding a bullet deceleration chamber into a housing having an open end through which a bullet travels. Duer's basket may be an insert, but it is not a bullet deceleration chamber. Furthermore, Duer's basket is not formed from "a plurality of generally flat pieces of steel," and, in light of the express teachings of Duer that the basket is to remove bullets without removing the filler material, it would not have been obvious to replace the basket with steel plates. While the Examiner suggests that the mesh of Duer could be replaced with plate steel, this is simply not reasonable in light of the teachings of Duer. Duer's insert is designed to

remove bullets from the sand. Thus, it must act as a sieve and allow the sand to pass through. Steel plate is not conducive to such a use. Because of its hardness, steel plate usually has to be cut with a cutting torch or similar instrument. No skilled artisan would attempt to form the large number of holes necessary for the steel plate to sift the bullets out of the sand. Not only would it be very time consuming and expensive, it defeats the very reason for using steel plate in the first place. Applicant strongly agrees that the ordinary artisan is not presumed to work in a vacuum. Any artisan of even marginal skill in the art would not view plate steel and mesh as being interchangeable materials in this context.

It is further clear that the combination of references cited by the Examiner would not result in attachment of "a plurality of the generally flat pieces of steel, and releasably attaching at least one of the generally flat pieces of steel to the plurality of generally flat pieces of steel which are fixedly attached." Nowhere in Duer or Fumero is such a method of attachment taught or suggested. While the Examiner suggests that one of skill in the art would provide releasable attachment to facilitate replacement, as needed. However, based on their structure and use, there is no need to replace the parts of Duer or Fumero as set forth in the claims. To the contrary, Fumero suggests that the pieces be rigidly attached. Duer, on the other hand, simply lacks a plurality of flat pieces of steel. Thus, there is no basis on which to modify Duer to meet the elements of the claim.

Based on the above, Applicant submits that all pending claims are in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Randall B. Bateman". The signature is fluid and cursive, with a large, sweeping loop at the end.

Randall B. Bateman



Registration No. 37,774  
Attorney for Applicant

10 West 100 South, Suite 425  
P.O. Box 1319  
Salt Lake City, Utah 84110  
Telephone: (801) 539-1900

Date: May 22, 2003